

REMARKS

I. STATUS OF CLAIMS

Claim 27 is pending. No amendment has been made herein.

II. REJECTION UNDER 35 U.S.C. § 103

A. Bhatt in view of Ramin, Samain and Mougín

The Examiner maintains the rejection of claim 27, as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,106,808 to Bhatt et al. ("Bhatt") in view of U.S. Patent No. 5,683,681 to Ramin et al. ("Ramin"), WO 98/22077 (U.S. Patent No. 6,423,297 as equivalent) to Samain et al. ("Samain") and WO 97/25021 (U.S. Patent No. 6,395,265 as equivalent) to Mougín et al. ("Mougín"). Office Action at page 2. Applicant continues to respectfully disagree and traverse the rejections for the following reasons.

As an initial matter, although Applicant believes the Examiner failed to meet the burden of establishing a *prima facie* case of obviousness with respect to the combination of Bhatt, Ramin, Samain and Mougín, in the interest of advancing prosecution Applicant notes that Samain cannot be prior art against the present application under 35 U.S.C. § 103(a). See *also* Response to Office Action submitted September 11, 2003.

As amended by the American Inventors Protection Act of 1999 ("AIPA"), § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Further, M.P.E.P. § 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999. . . .

The present application was filed on October 3, 2000. Samain, on the other hand, issued on July 23, 2002, from an application filed November 24, 1997, and therefore, Applicant notes that Samain is only available as § 102(e) prior art because Samain was based on an application with an effective U.S. filing date of November 24, 1997, which precedes the priority date of the present application.

As discussed above, any rejection under 35 U.S.C. § 103(a) based on § 102(e) prior art is subject to the conditions of § 103(c). Samain and the instant application were subject to an obligation of assignment to L'Oréal S.A. at the time the presently claimed invention was made, as evidenced by the assignment information recorded for Samain on March 23, 1998, at Reel 009119, Frame 0035, and the assignment information recorded for the instant application on October 3, 2000, at Reel 011165, Frame 0231. Thus, Samain cannot be prior art against the present application under 35 U.S.C. § 103(a).

Since the Examiner relied upon Samain for teaching of an anionic polymer (i.e., the specific at least film-forming polymer recited in the present claims), the cited combination of references is deficient in that the combination fails to teach all the claim

elements. For that reason alone, a *prima facie* case of obviousness cannot be established and Applicant respectfully requests the withdrawal of the rejection.

With respect to Bhatt in view of Ramin and Mougin, the Examiner argued, among other things, that:

A person of ordinary skill in the art would have been motivated to modify Bhatt's method by incorporating the copolymer disclosed by Mougin . . . or substituting the polyurethane with the copolymer and other film forming agent such as those disclosed by Ramin because the copolymers disclosed by Mougin et al, and as herein claimed, are known to provide superior properties as film forming agent of film forming additive for hair products and is particularly known to be useful in aerosol form.

Office Action at page 4.

Applicant reiterates the traversal for the reasons of record and as further discussed below. The Examiner's argument that one of two combinations proposed above is *prima facie* case obvious is conclusory at best, and not supported by any clear and particular evidence to support a *prima facie* case of obviousness. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Examiner presented no supported motivation for either suggested combination.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the

resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

Bhatt explicitly teaches that the polyoxyethylene segments in the carboxylated polyurethane resin contributes to both hydrophilicity and softening of the polyurethane. See Bhatt at col. 5, ll. 48-55. Moreover, Bhatt teaches that "hydrophilicity of the polyurethane resin is an unexpected important property" *Id.* at col. 10, ll. 23-37. Second hair fixative resins are added to the composition in order to achieve advantageous results and is preferably a "hydrophobic compound" and is "a hard, brittle compound having a glass transition temperature (T_g) of about 100°C or greater" *Id.* at col. 11, ll. 50-60. Thus, not only does Bhatt not teach the particular claimed polycondensate (i.e., does not comprise organopolysiloxanes), but Bhatt fails to teach the particular film-forming polymer. Instead, Bhatt teaches a specific hydrophobic resin that is hard and brittle with high glass transition temperature.

The Examiner's proposal to modify the composition of Bhatt by incorporating the polycondensate of Mougine because the "copolymers disclosed by Mougine et al . . . are known to provide superior properties" is an overly broad conclusion, particularly in view of the teachings in Mougine.

Mougin discusses the particularities of combining organopolysiloxanes with non-silicone polymers:

These [silicone] polymers do not have good mechanical properties for ensuring good film-formation; they thus need to be combined with other polymers which provide mechanical properties. Polyorganopolysiloxanes, in particular polydimethylsiloxanes, are incompatible with most of the non-silicone polymers which provide mechanical properties.

Mougin at col. 2, ll. 10-20.

Mougin teaches that there are certain obstacles to overcome when combining silicone and non-silicone polymers. One skilled in the art would have no reason to expect that either by incorporating the copolymer of Mougin into the composition or substituting the polyurethane of Bhatt with the copolymer of Mougin would lead to compatible polymers or a stable composition with the same beneficial results already obtained in Bhatt (i.e., hydrophilic and softening of the polyurethane).

Thus, the Examiner's conclusion is not based on Mougin and Bhatt as a whole, but instead, based on mere speculation and hindsight in view of the teachings of the present application. However, it is improper, as the Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not Applicant's specification. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-1532 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure."). Using an Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of section 103 of judging obviousness at the point in time when the invention was made. See *Grain*

Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

The addition of Ramin to the combination of Bhatt and Mougin does not remedy the apparent deficiencies described above. When viewed as a whole, Ramin does not teach the requisite film-forming polymers, but instead teaches nail compositions that comprise a dispersion of water -insoluble polymers and a plasticizer. See Ramin Abstract and col. 1, ll. 35-45. The film-forming polymers of Ramin do contain the polymer recited in the claims, namely polymers comprising carboxylic units and/or polymers comprising units derived from suphonic acid. Applicants' claim 27. Ramin's teaching of general film-forming polymers that are water insoluble is different from those recited in the present application. See page 15, line 17 - page 21 of the as-filed specification, line 9; see *also* Ramin at col. 1, ll. 35-45. This is further evidence that the specific film-forming polymer recited in the present application is missing. As such, the Examiner failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn. Applicant respectfully requests that the rejection be withdrawn.

B. Mougin in view of Samain, Bhatt and Malawer

Claim 27 is further rejected under 35 U.S.C. § 103(a). as unpatentable over the combination of Mougin and Samain in further view of Bhatt and U.S. Patent No. 5,458,871 to Malawer et al. ("Malawer"). Office Action at page 5. In view of this cited combination of references, Applicant reasserts that it would not have been obvious to come the references to render the instant application obvious. Essentially, the Examiner contends that Mougin teaches block copolymers of polyurethane and polysiloxane and Samain teaches the particular film-forming polymer but Mougin fails to

teach the requisite particle size of polymer. *Id.* The Examiner relies on Bhatt and Malawer for their teachings that “about 20 to 150 microns . . . may be used” and “it is generally considered in the art that small droplet is desirable” respectively. Thus, according to the Examiner, “it is *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form a third composition” and “it is not inventive to discover the optimum or workable ranges by routine experimentation.” *Id.* at page 6. Applicant continues to disagree and traverse the rejection in view of the reasons of record and the following.

Applicant previously pointed out to the Examiner that Samain cannot be considered as prior art. For that reason alone, a *prima facie* case of obviousness cannot be made, as the cited combination of references fail to teach the particular film-forming polymer recited in claim 27 and the rejection should be withdrawn.

Among other deficiencies in the Examiner's argument, as Applicant already highlighted, *In re Kerkhoven* is not applicable to the suggested combination because, as characterized by the CCPA, the claims at issue in *Kerkhoven* “require no more than the mixing together of two conventional spray-dried detergents.” *Kerkhoven* at 1072. Nowhere in the *Kerkhoven* decision does the court hold that the combining of ingredients known to be useful for the same purpose in order to form a composition that can be used for the same purpose is *prima facie* obvious. Rather, the facts of the case, which the decision is necessarily based upon, relate to the combination of two compositions, essentially comprising one ingredient, both individually useful for the same purpose, in order to create a third composition, also useful for the same purpose of the first two compositions. *Kerkhoven* at 1071. In contrast, the presently claimed

polycondensate and film-forming polymer are not directed to the mixture of two prior art compositions. It is not merely the "mixing together" of two hair compositions. Rather, as in, for example, claim 27, it is a combination of specific ingredients, i.e. a particular polycondensate and a particular anionic film-forming polymer, that leads to improved properties such as better spraying quality. See page 2, line 19 - page 3, line 4 of the as-filed specification.

Thus, the Examiner is arguing a standard that would render obvious every cosmetic composition that is comprised of ingredients known to be useful in cosmetic compositions. Such a standard was not the holding in *Kerkhoven* and is not the law in determining obviousness. This position is supported by the fact that the literal combination of Mougin, Bhatt and Malawer would not give rise to the claimed invention. Thus, the Examiner's application of *Kerkhoven* is inapposite to the present case.

Moreover, although Malawer may teach that small polymeric material droplet size is desirable, in view of Malawer as a whole, this teaching does not remedy the deficiencies of the other cited references. Malawer teaches hair spray compositions that are microemulsions of water-insoluble polymers, a surfactant and predominantly water. See Malawer at col. 2 at ll. 20-35. Thus, Malawer neither teaches nor suggests, using a combination of a polycondensate and anionic film-forming polymer to yield a hair composition with droplets having an average diameter of less than or equal to 80 μm . Meaning, Malawer's teaching of the droplet size is specific to the ingredients used in Malawer's compositions. Malawer does not teach or suggest a general droplet size for any combination of ingredients. This evidence of the Examiner's continued

reconstruction of the present invention by using isolated pieces of the cited references to contravene the meaning of Section 103.

For at least the reasons provided above, the Examiner failed to establish a *prima facie* case of obviousness based on the combination of Mougin, Samain, Bhatt and Malawer.

III. CONCLUSION

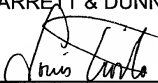
In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

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